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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ARYANPOUR, MITRA

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,948

Applicant(s)

GAGNON, PAUL R.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>24 November 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: an individual's ability to look in a specific direction at a sporting object being controlled by the individual between 0 and 90 degrees relative to the individual's vertical field of vision

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Maged (WO 96/32979 A1).

Regarding claim 1, Maged discloses a piece of material (article 10 having two members 101 and 102) having a thickness (as best seen in figure 2b, the members have a thickness), said piece of material having an adhesive coating or layer (layer of adhesive 101b (102b)) for positioning said piece of material on a portion of an individual's face (see figure 2a). The thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual between 0 and 90 degrees relative to the individual's vertical field of vision; and so that said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said

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sporting object (see page 4, lines 25-31 and page 5, lines 1-7). It should be noted that the preamble, *a sports vision training device*, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness.

Regarding claim 2, Maged shows in figure 2b that the piece of material has a thickness, the thickness being sufficient to direct the individual's vision up and toward the field of play and players on said field of play (page 5, lines 1-7).

Alternatively:

4. Claims 1-4, 6, 9-12, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Micchia et al (4,719,909).

Regarding claim 1, Micchia et al discloses a piece of material (patch 7) having a thickness (as best seen in figure 2, the patch has a thickness), said piece of material having an adhesive coating or layer (adhesive layer 13) for positioning said piece of material on a portion of an individual's face (see figure 1); the thickness of the material is sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual between 0 and 90 degrees relative to the individual's vertical field of vision; and so that said piece of material inherently interferes with said individual's ability to look at said sporting object while attempting to control said sporting object (column 2, lines 14-45).

Regarding claim 2, Micchia et al shows in figure 2 that the piece of material has a thickness, the thickness being sufficient to inherently direct the individual's vision up and toward the field of play and players on said field of play.

Regarding claim 3, Micchia et al shows said piece of material (patch 7) is formed from a porous material (see column 2, lines 22-27) on one side and a pliable sheet material such as medical adhesive bandages on the opposite side (see column 2, lines 28-36). It should be noted that the common and well-known medical adhesive bandages are formed from open-cell foam material.

Regarding claim 4, Micchia et al shows said adhesive coating or layer includes means for absorbing moisture and for transferring said moisture from a surface of an individual's skin to the piece of material to allow the moisture to evaporate (see column 3, lines 38-42).

Regarding claim 6, Micchia et al shows said piece of material (patch 7) has an upper surface (light absorbing surface 12) and said upper surface is intermittently grooved (see figure 2; also see column 2, lines 46-55), to permit momentary glances at said sports object.

Regarding claim 9, Micchia et al shows said device is disposable (see column 3, lines 35-37).

Regarding claim 10, note the rejection of claims 1, 2 and 9.

Regarding claim 11, note the rejection of claim 3.

Regarding claim 12, note the rejection of claim 4.

Regarding claim 14, note the rejection of claim 6.

Regarding claim 15, Micchia et al shows said vision restriction devices are attached to an individual's face along side each eye to inherently restrict the individual's peripheral vision (see figure 1).

Regarding claim 16, note the rejection of claim 3.

Regarding claim 18, during normal use and operation of the Micchia et al device, the method step set forth by applicant in the claim is inherently provided.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909).

Regarding claims 7 and 8, Micchia et al does not disclose expressly the addition of indicia or logo on the upper surface of the piece of material. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to include indicia or logo on the upper surface of the piece of material, because Applicant has not disclosed that the inclusion of indicia or logo, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the piece of material taught by Micchia et al or the claimed piece of material because both material perform the same function of improving under-eye light absorbing device which can be easily applied and easily stripped in one piece as desired. Therefore, it would have been an obvious matter of design choice to modify Micchia et al to obtain the invention as specified in claims 7 and 8.

7. Claims 5, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Micchia et al (4,719,909) in view of Official Notice.

Regarding claim 5, Micchia et al does not disclose expressly that the moisture absorbing and transferring means comprises a hydrocolloidal material incorporated into the adhesive layer. The Examiner takes Official Notice that the use of hydrocolloidal material as a moisture absorbing material is well known in the medical art and an obvious inclusion for the Micchia et al patch.

Regarding claim 13, note the rejection of claims 4 and 5.

Regarding claim 17, note the rejection of claim 5.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
29 November 2004


MITRA ARYANPOUR
PATENT EXAMINER